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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/536,679

05/27/2005

Jurgen Schmiedl

4-22804/A/PCT

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08/03/2006

CIBA SPECIALTY CHEMICALS CORPORATION

PATENT DEPARTMENT

540 WHITE PLAINS RD

P O BOX 2005

TARRYTOWN, NY 10591-9005

EXAMINER

POWERS, FIONA

ART UNIT

PAPER NUMBER

1626

DATE MAILED: 08/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/536,679	Applicant(s) SCHMIEDL ET AL.	
	Examiner Fiona T. Powers	Art Unit 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 8-13 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4, 5, and 8 to 13 is/are rejected.
- 7) ☒ Claim(s) 3 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>8/29/05</u> . | 6) <input type="checkbox"/> Other: ____. |

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Receipt is acknowledged of the preliminary amendment filed May 27, 2005 and the information disclosure statement filed August 29, 2005, which have been entered in the file.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 4, 5 and 11 to 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boedeker et al. (US 3223470) or Japanese Patent 57-42985 or Japanese Patent 56-118975 or Japanese Patent 50-157422, cited by applicants.

Determination of the scope and content of the prior art (MPEP §2141.01)

The references disclose structurally similar anthraquinone reactive dyes that are structurally similar to the claimed reactive dyes of the formula (1) where Z_1 is of the formula (2a) where Y is $-\text{CH}_2\text{CH}_2\text{U}$ or is of the formula (2d) where Hal is Br. Note Example 9 of Boedeker et al.; Dyes 1 to 4 on page 4 and Dyes 20 to 23 on pages 5 to 6 of JP 57-42985; the dyes in the left-hand column on page 3 of JP 56-118975; and Dye 16 on page 4 of JP 50-157422. The references also disclose a process of dyeing and process for preparing the dyes which is similar to

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the claimed process. Note the examples mentioned above and the corresponding abstracts of the Japanese patents.

Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)

The dyes of the references differ from those claimed only in that hydrogen replaces the C₁-C₄alkyl group that corresponds to R₁ of the claimed dyes.

Finding of prima facie obviousness---rational and motivation (MPEP §2142-2413)

However, it is obvious to replace hydrogen with a lower alkyl group on a nitrogen atom. Note Ex parte Tweit, 167 USPQ 688. One of ordinary skill in the art would have been motivated to make the claimed dyes with the expectation that additional dyes useful for the dyeing of polyamide fibers would be obtained. The claimed dyes would have been rendered obvious by the structurally similar dyes of the reference in the absence of any unobvious property. The claimed process for preparing the dyes and process of dyeing would also have been rendered obvious in the absence of any unobvious result.

Claims 1, 2, 4, 5 and 8 to 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lehmann et al. (US 5779740), cited by applicants.

Determination of the scope and content of the prior art (MPEP §2141.01)

The reference discloses structurally similar anthraquinone reactive dyes that are structurally similar to the claimed reactive dyes of the formula (1) where Z₁ is of the formula (2b),

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(2c) or (2d). Note Example 6 in particular Dye 108, and Preparation Examples 3, 4, 11 and 12. Example 6 discloses a process similar to that of claims 8 to 10 where a dye similar to instant formula (1) is used to dye polyamide together with dyes that correspond to formula (4) and (6) of instant claim 8. The Preparation Examples mentioned above prepare dyes similar to the claimed dye of the formula (1) by a similar process.

Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)

The dyes of the references differ from those claimed only in that hydrogen replaces the C₁-C₄alkyl group that corresponds to R₁ of the claimed dyes.

Finding of prima facie obviousness---rational and motivation (MPEP §2142-2413)

However, it is obvious to replace hydrogen with a lower alkyl group on a nitrogen atom. Note Ex parte Tweit, 167 USPQ 688. One of ordinary skill in the art would have been motivated to make the claimed dyes with the expectation that additional dyes useful for the dyeing of polyamide fibers would be obtained. The claimed dyes would have been rendered obvious by the structurally similar dyes of the reference in the absence of any unobvious property. The claimed process for preparing the dyes and process of dyeing would also have been rendered obvious in the absence of any unobvious result.

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The references made of record and not relied upon show the state of the art.

Claim 3 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fiona T. Powers whose telephone number is 571-272-0702. The examiner can normally be reached on Monday - Friday 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on 571-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Fiona T. Powers

Fiona T. Powers
Primary Examiner
Art Unit 1626

ftp
August 1, 2006